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In re Application of :  
ZHANG et al. :  
U.S. Application No. 10/019,879 :  
PCT No.: PCT/CN00/00293 :  
Int. Filing Date: 28 September 2000 :  
Priority Date: None :  
Attorney Docket No.: 42390.P9658 :  
For: A METHOD AND APPARATUS FOR :  
EXTRACTING ENTITY NAMES AND :  
THEIR RELATIONS :

## DECISION ON PETITION

This is a decision on applicants' "Response to Notice to File Missing Parts of Application" filed 12 November 2003, which is being treated as a Petition under 37 CFR 1.47(a) to accept the application without the signature of joint-inventor, Joe F. Zhou. The petition fee will be charged to Deposit Account no. 02-2666.

### BACKGROUND

On 28 September 2000, applicants filed international application PCT/CN00/00293 which claimed no priority date. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 04 April 2002. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the international filing date, 28 March 2003.

On 27 December 2001, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a copy of the international application.

On 01 May 2003, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 12 November 2003, applicants filed the present petition under 37 CFR 1.47(a) and a four-month extension of time.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17, (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1), (3), and (4) have been satisfied.

As to item (2), petitioner states that Joe F. Zhou cannot be found or reached after diligent effort. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

A review of the present petition reveals that petitioner has not provided an acceptable showing that a diligent effort was made to locate the nonsigning inventor, Joe F. Zhou. Petitioner has provided a copy of the cover letter addressed to Mr. Zhou mailed 29 September 2003 by Registered Mail. The Registered Mail label, provided by the petitioner, is stamped by the China Postal Service as "removed." However, all other attempts to locate the nonsigning have been conducted by Applicant's Database Group and cannot be considered as firsthand knowledge. As stated above, copies of documentary evidence such as internet searches, certified mail return receipt, cover letter of instructions, telegrams, etc., should be supplied by a person having firsthand knowledge of the facts. The single mailing of the papers to the nonsigning inventor's last known address does not constitute a "diligent effort" to locate the inventor.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Joe F. Zhou under 37 CFR 1.47(a) at this time.

**CONCLUSION**

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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